

147



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,551	12/20/2001	Indu Parikh	WAPH.002.04US	6080

  

31272	7590	03/23/2004
-------	------	------------

RAE-VENTER LAW GROUP, P.C.  
 P.O. BOX 1898  
 MONTEREY, CA 93942-1898

  

EXAMINER	
WEHBE, ANNE MARIE SABRINA	

  

ART UNIT	PAPER NUMBER
1632	

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/029,551

Applicant(s)

PARIKH ET AL.

Examiner

Anne Marie S. Wehbe

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-37 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, 19, and 23 drawn to methods of treating diabetes by administering a gastrin/CCK receptor ligand and an EGF receptor ligand, classified in class 514, subclass 2
- II. Claims 4-7, 20, 25-27, and 34-35, drawn to methods of transplanting mature insulin-secreting beta-cells, classified in class 424, subclass 93.1.
- III. Claims 20-22, 24, 28-29, and 34-35, drawn to methods for obtaining an expanded population of insulin-secreting beta cells ex vivo, classified in class 435, subclasses 325 and 395.
- IV. Claims 30-33, drawn to kits comprising a gastrin/CCK receptor ligand and an EGF receptor ligand, classified in class 530, subclass 350.
- V. Claims 36-37, drawn to methods of administering a compound that increases the secretion of an endogenous gastrin or cholecystokinin, classified in class 424, subclass 600.

The inventions are distinct, each from the other because of the following reasons:

- 1) Invention I is patentably distinct from inventions II and III in that the active ingredient of invention I is a combination of two proteins which are directly administered to the patient. As such, invention I does not require the use of the isolated pancreatic beta cells of inventions II and III. Further, proteins are substantially different in physical, chemical, structural, and functional

properties that whole cells, are made using different techniques and can be used for substantially different purposes.

2) Inventions II and III are related as process of making and process of using the product, insulin-secreting beta cells. The use as claimed cannot be practiced with a materially different product. Since the product is not allowable, restriction is proper between said method of making and method of using. The product claims, claims 20, 25, and 34-35 will be examined along with the elected invention (MPEP § 806.05(i)).

3) Inventions I-III and invention IV are related as product and process of use. The inventions can be shown to be distinct if **either** or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, a composition comprising a gastrin/CCK receptor ligand and an EGF receptor ligand can be used in a variety of *in vitro* and *in vivo* assays and methods other than those recited in inventions I-III, including the use of the compositions in *in vitro* cell free binding assays.

4) Inventions I-IV and V are unrelated. Invention V recites the administration of compounds that are not required in inventions I-IV and which are structurally, chemically, physically, and functionally different from a gastrin/CCK receptor ligand, an EGF receptor ligand, or insulin secreting beta-cells.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, different

classification, and different search requirements, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication from the examiner should be directed to Anne Marie S. Wehbé, Ph.D., whose telephone number is (571) 272-0737. The examiner can be reached Monday- Friday from 10:30-7:00 EST. If the examiner is not available, the examiner's supervisor, Amy Nelson, can be reached at (571) 272-0804. For all official communications, the technology center fax number is (703) 872-9306. For informal, non-official communications only, the examiner's direct fax number is (571) 273-0737.

Dr. A.M.S. Wehbé

ANNE M. WEHBE' PH.D  
PRIMARY EXAMINER

